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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
	:	Examiner: Betty J. Forman
TADASHI OKAMOTO, et al.)	
	:	Group Art Unit: 1634
Application No.: 09/988,873)	
	:	
Filed: November 21, 2001)	
	:	
For: TERMINAL LABELED)	
PROBE ARRAY AND	:	
METHOD OF MAKING IT)	February 18, 2003

Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO RESTRICTION/ELECTION REQUIREMENT

Sir:

In response to the Restriction Requirement dated January 16, 2003,
Applicants hereby elect to prosecute the Group I claims, namely Claims 1 to 9. The
Restriction Requirement is, however, respectfully traversed.

I hereby certify that this correspondence is being deposited
with the United States Postal Service as first class mail in an
envelope addressed to: Commissioner of Patents and Trade-
marks, Washington, D.C. 20231 on Feb 18, 2003
(Date of Deposit)

Michael K. O'Neill

Name of Attorney for Applicant

Signature

Feb 18, 2003
Date of Signature

Here, nearly all of the features recited in the process claims of Group I are similar to those features found in the product claims of Group II. In view of this near identity of features, it is respectfully submitted that on this record it is not possible that the product of the Group II claims could be made by another process that "differs materially" from the Group I claims, which is the standard set by MPEP § 806.05(f). It should be understood that Applicants are not saying that the Group II probe could not be made by a process that differs somewhat from the Group I claims; Applicants are merely saying that such a process would not differ "materially" as that term is used in connection with the USPTO's restriction practice.

In its reasons for insisting on restriction between the Group I and II claims, the Office Action cited to MPEP § 2113, apparently in support of the position that the product of the Group II claims, even though defined in product-by-process format, nevertheless does not require the specifics of the process. Applicants would respectfully stress that such a position is only half-correct: a product-by-process claim is met by a product made by a different process only if the product is identical to that claimed. Here, no evidence has been provided that the hypothetical "direct deposit" method results in a product identical to that obtained by the claimed "sequential synthesis" method. As a result, there is an insufficient basis for the Office Action's assertion that the Group II claims could be made by a process that differs "materially" from the process of the Group I claims, as explained above.

Also, nearly all of the features recited in the processes of the Groups III and IV claims are similar to those features found in the product of the Group II claims. In view of this near identity of features, it is respectfully submitted that on this record it is not

possible to demonstrate that the product of the Group II claims could be used by another process that "differs materially" from the Groups III and IV claims, which is the standard set by MPEP § 806.05(h). It should be understood that Applicants are not saying that the Group II probe could not be used by a process that differs somewhat from the Groups III and IV claims; Applicants are merely saying that such a process would not differ "materially" as that term is used in connection with the USPTO's restriction practice.

The restriction requirement between Groups I and IV was based on MPEP § 806.04 and MPEP § 808.01. Under both MPEP § 806.04 and MPEP § 808.01, Groups I and IV are independent if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions or different effects. However, MPEP § 808.01 makes it clear that such a situation, in which the two groups of claims are not connected in design, operation and effect, is rare. As a demonstration of two independent inventions, MPEP § 806.04 gives the example of a process of painting a house and a process of boring a well while MPEP § 808.01 gives the example of a necktie and a locomotive bearing. As MPEP § 808.1 and the above examples demonstrate, the standard required for a showing of two independent inventions is high and rarely achieved. Applicants submit that this standard has not been met because Groups I and IV are at least somewhat connected in design, operation and effect, especially since many of the features recited in process of the Groups I claims are similar to those features found in the process of the Group IV claims.

The restriction between Groups III and IV was also based on MPEP § 806.04 and MPEP § 808.01, and Applicants again submit that the standard has not been met. Applicants submit that Groups III and IV also are at least somewhat connected in

design, operation and effect as many of the features recited in the process of the Group III claims are similar to those features found in the process of the Group IV claims.

Further, according to 37 CFR 1.141(b):

“Where claims to all three categories, product, process of making, and process of use, are included in a national application, a three way requirement for restriction can only be made where the process of making is distinct from the product. If the process of making and the product are not distinct, the process of using may be joined with the claims directed to the product and the process of making the product even though a showing of distinctness between the product and process of using the product can be made.”

Finally, traversal is also on the ground that there would not be undue burden in examining all groups of claims in a single application. In particular, MPEP § 808 makes clear that in order to require restriction between independent or distinct inventions, reasons for insisting upon a restriction requirement, such as undue burden, must also be shown. In the present instance, it is not believed that there would be an undue burden in examining the claims of Groups I, II, III and IV in a single application. As stated above, nearly all of the features recited in the processes and product of the Groups I, II, III and IV claims are similar. Also, Groups II, III and IV are classified in the same class. As such, although it is true that Group I claims a method of production, Group II claims a product, and Groups III and IV claim methods of use, it is nevertheless believed that the four groups of claims are not so unrelated as would require a burden on the Examiner that is significantly beyond that of the normal burdens of examination.

Applicants' undersigned attorney may be reached in our Costa Mesa,
California office at (714) 540-8700. All correspondence should continue to be directed to
our below-listed address.

Respectfully submitted,


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